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09/687,499	10/13/2000	Christopher C. Winslade	0020	1146

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EXAMINER

YOUNG, JOHN L

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/687,499

Applicant(s)
Winslade et al.,

Examiner
John Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 13, 2000
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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FIRST ACTION REJECTION

DRAWINGS

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

ABSTRACT OBJECTION—37 CFR 1.72(b)

2. Applicant is reminded of the proper format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. See MPEP § 608.01(b). In this case, the abstract exceeds 150 words. Appropriate correction is required.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Katz US 6,055,513 (Apr. 25, 2000) [US f/d: 03/11/1998] (herein referred to as “Katz”) in view of Palmer US 6,505,773 (01/14/2003) [US f/d: 04/03/1998] (herein referred to as “Palmer”).

As per independent claim 1, Katz (the ABSTRACT; FIG. 6; col. 2, ll. 55-67; col. 3, ll. 15-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 11, ll. 30-67; col. 13, ll. 25-67; col. 14, ll. 39-67; col. 17, ll. 36-67; col. 18, ll. 1-15; col. 23, ll. 60-67; col. 24, ll. 1-5; col. 26, ll. 66-67; col. 27, ll. 1-22; col. 28, ll. 20-29; and whole document) shows “A method of processing a coupon of a first party, the first party having a first system, the method comprising: offering by a second system of a second party, an item online for sale at a sales price amount; associating the coupon of

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the first party with the item, the coupon having a coupon amount; receiving, by the second system, an online purchase request from a buyer for the item being offered online. . . .”

Katz lacks explicit recitation of: “responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to the sales price amount less the coupon amount for the item; and electronically communicating, by the second system to the first system, an indication regarding the collection from the buyer of the purchase amount.”

Palmer (the ABSTRACT; col. 1, ll. 50-60; and col. 1, ll. 5-10) discloses: “*an online coupon issuing and redemption system.*”

Palmer (the ABSTRACT; FIG. 1 through FIG. 9; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; and col. 6, ll. 1-50) in view of Katz (the ABSTRACT; FIG. 6; col. 2, ll. 55-67; col. 3, ll. 15-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 11, ll. 30-67; col. 13, ll. 25-67; col. 14, ll. 39-67; col. 17, ll. 36-67; col. 18, ll. 1-15; col. 23, ll. 60-67; col. 24, ll. 1-5; col. 26, ll. 66-67; col. 27, ll. 1-22; col. 28, ll. 20-29; and whole document) shows: “A method of processing a coupon of a first party, the first party having a first system, the method comprising: offering by a second system of a second party, an item online for sale at a sales price amount; associating the coupon of the first party with the item, the coupon having a coupon amount; receiving, by the second system, an online purchase request from a buyer for the item being offered online; responding, by the second system, to the

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online purchase request by collecting from the buyer a purchase amount corresponding to the sales price amount less the coupon amount for the item; and electronically communicating, by the second system to the first system, an indication regarding the collection from the buyer of the purchase amount.”

Palmer (the ABSTRACT; col. 1, ll. 50-60; and col. 1, ll. 5-10) proposes “*online coupon issuing and redemption*” modifications that would have applied to the system of Katz. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of Palmer with the teachings of Katz because such combination would have provided means to ensure that “*Only the valid coupons matching the list in the database may be actually redeemed. . . . [and] to electronically reimburse the merchants. . . .*” (see Palmer (col. 2, ll. 43-57)) and because such combination would have provided means “*for effecting remote commerce . . . which are particularly adapted for the intelligent selection and proffer of products, services or information to a user or customer.*” (See Katz (col. 8, ll. 34-40)).

As per claim 2, Katz in view of Palmer shows the method of claim 1. (See the rejection of claim 1 supra).

Katz lacks explicit recitation of “responding by the first system to the indication by facilitating payment of a reimbursement amount corresponding to the coupon amount to the first party.”

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Palmer (the ABSTRACT; FIG. 1 through FIG. 9; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; and col. 6, ll. 1-50) in view of Katz (the ABSTRACT; FIG. 6; col. 2, ll. 55-67; col. 3, ll. 15-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 11, ll. 30-67; col. 13, ll. 25-67; col. 14, ll. 39-67; col. 17, ll. 36-67; col. 18, ll. 1-15; col. 23, ll. 60-67; col. 24, ll. 1-5; col. 26, ll. 66-67; col. 27, ll. 1-22; col. 28, ll. 20-29; and whole document) shows:

“responding by the first system to the indication by facilitating payment of a reimbursement amount corresponding to the coupon amount to the first party.”

Palmer (the ABSTRACT; col. 1, ll. 50-60; and col. 1, ll. 5-10) proposes “*online coupon issuing and redemption*” modifications that would have applied to the system of Katz. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of Palmer with the teachings of Katz because such combination would have provided means to ensure that “*Only the valid coupons matching the list in the database may be actually redeemed. . . . [and] to electronically reimburse the merchants. . . .*” (see Palmer (col. 2, ll. 43-57)) and because such combination would have provided means “*for effecting remote commerce . . . which are particularly adapted for the intelligent selection and proffer of products, services or information to a user or customer.*” (See Katz (col. 8, ll. 34-40)).

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As per claim 3, Katz (the ABSTRACT; FIG. 6; col. 2, ll. 55-67; col. 3, ll. 15-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 11, ll. 30-67; col. 13, ll. 25-67; col. 14, ll. 39-67; col. 17, ll. 36-67; col. 18, ll. 1-15; col. 23, ll. 60-67; col. 24, ll. 1-5; col. 26, ll. 66-67; col. 27, ll. 1-22; col. 28, ll. 20-29; and whole document) in view of Palmer (the ABSTRACT; FIG. 1 through FIG. 9; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; and col. 6, ll. 1-50) shows the method of claim 2. (See the rejection of claim 2 supra).

Katz lacks explicit recitation of “wherein the facilitating comprises initiating an electronic payment of the reimbursement amount.”

Palmer (the ABSTRACT; FIG. 1 through FIG. 9; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; and col. 6, ll. 1-50) in view of Katz (the ABSTRACT; FIG. 6; col. 2, ll. 55-67; col. 3, ll. 15-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 11, ll. 30-67; col. 13, ll. 25-67; col. 14, ll. 39-67; col. 17, ll. 36-67; col. 18, ll. 1-15; col. 23, ll. 60-67; col. 24, ll. 1-5; col. 26, ll. 66-67; col. 27, ll. 1-22; col. 28, ll. 20-29; and whole document) shows: “wherein the facilitating comprises initiating an electronic payment of the reimbursement amount.”

Palmer (the ABSTRACT; col. 1, ll. 50-60; and col. 1, ll. 5-10) proposes “*online coupon issuing and redemption*” modifications that would have applied to the system of Katz. It would have been obvious to a person of ordinary skill in the art at the time of the

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invention to combine the disclosure of Palmer with the teachings of Katz because such combination would have provided means to ensure that *“Only the valid coupons matching the list in the database may be actually redeemed. . . . [and] to electronically reimburse the merchants. . . .”* (see Palmer (col. 2, ll. 43-57)) and because such combination would have provided means *“for effecting remote commerce . . . which are particularly adapted for the intelligent selection and proffer of products, services or information to a user or customer.”* (See Katz (col. 8, ll. 34-40)).

As per claims 4-13, Katz (the ABSTRACT; FIG. 6; col. 2, ll. 55-67; col. 3, ll. 15-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 11, ll. 30-67; col. 13, ll. 25-67; col. 14, ll. 39-67; col. 17, ll. 36-67; col. 18, ll. 1-15; col. 23, ll. 60-67; col. 24, ll. 1-5; col. 26, ll. 66-67; col. 27, ll. 1-22; col. 28, ll. 20-29; and whole document) in view of Palmer (the ABSTRACT; FIG. 1 through FIG. 9; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; and col. 6, ll. 1-50) shows the method of claim 1 and subsequent base claims depending from claim 1.

Katz in view of Palmer lacks explicit recitation of the elements and limitations of claims 4-13, even though Katz in view of Palmer suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 4-13 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of

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the invention to include the elements and limitations of claims 4-13, because such selection would have provided means to ensure that *“Only the valid coupons matching the list in the database may be actually redeemed. . . . [and] to electronically reimburse the merchants. . . .”* (see Palmer (col. 2, ll. 43-57)) and because such selection would have provided means *“for effecting remote commerce . . . which are particularly adapted for the intelligent selection and proffer of products, services or information to a user or customer.”* (See Katz (col. 8, ll. 34-40)).

As per independent claim 14, Katz (the ABSTRACT; FIG. 6; col. 2, ll. 55-67; col. 3, ll. 15-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 11, ll. 30-67; col. 13, ll. 25-67; col. 14, ll. 39-67; col. 17, ll. 36-67; col. 18, ll. 1-15; col. 23, ll. 60-67; col. 24, ll. 1-5; col. 26, ll. 66-67; col. 27, ll. 1-22; col. 28, ll. 20-29; and whole document) shows *“A method of processing a promotion, the method comprising: offering by a sales system of a first party, an item online for sale at a sales price amount; associating a promotion with the item, the promotion having a promotion amount; receiving an online purchase request from a buyer for the item; responding, by the sales system, to the online purchase request by collecting from the buyer a purchase amount corresponding to the sales price amount less the promotion amount; and facilitating payment, by a promotion system, of a reimbursement amount corresponding to the promotion amount to the first party.”*

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Katz lacks explicit recitation of: responding, by the sales system, to the online purchase request by collecting from the buyer a purchase amount corresponding to the sales price amount less the promotion amount; and facilitating payment, by a promotion system, of a reimbursement amount corresponding to the promotion amount to the first party.”

Palmer (the ABSTRACT; col. 1, ll. 50-60; and col. 1, ll. 5-10) discloses: “*an online coupon issuing and redemption system.*”

Palmer (the ABSTRACT; FIG. 1 through FIG. 9; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; and col. 6, ll. 1-50) in view of Katz (the ABSTRACT; FIG. 6; col. 2, ll. 55-67; col. 3, ll. 15-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 11, ll. 30-67; col. 13, ll. 25-67; col. 14, ll. 39-67; col. 17, ll. 36-67; col. 18, ll. 1-15; col. 23, ll. 60-67; col. 24, ll. 1-5; col. 26, ll. 66-67; col. 27, ll. 1-22; col. 28, ll. 20-29; and whole document) shows: “A method of processing a promotion, the method comprising: offering by a sales system of a first party, an item online for sale at a sales price amount; associating a promotion with the item, the promotion having a promotion amount; receiving an online purchase request from a buyer for the item; responding, by the sales system, to the online purchase request by collecting from the buyer a purchase amount corresponding to the sales price amount less the promotion amount; and facilitating payment, by a promotion system, of a reimbursement amount corresponding to the promotion amount to the first party.”

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Palmer (the ABSTRACT; col. 1, ll. 50-60; and col. 1, ll. 5-10) proposes “*online coupon issuing and redemption*” modifications that would have applied to the system of Katz. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the disclosure of Palmer with the teachings of Katz because such combination would have provided means to ensure that “*Only the valid coupons matching the list in the database may be actually redeemed. . . . [and] to electronically reimburse the merchants. . . .*” (see Palmer (col. 2, ll. 43-57)) and because such combination would have provided means “*for effecting remote commerce . . . which are particularly adapted for the intelligent selection and proffer of products, services or information to a user or customer.*” (See Katz (col. 8, ll. 34-40)).

As per claims 15-20, Katz (the ABSTRACT; FIG. 6; col. 2, ll. 55-67; col. 3, ll. 15-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 11, ll. 30-67; col. 13, ll. 25-67; col. 14, ll. 39-67; col. 17, ll. 36-67; col. 18, ll. 1-15; col. 23, ll. 60-67; col. 24, ll. 1-5; col. 26, ll. 66-67; col. 27, ll. 1-22; col. 28, ll. 20-29; and whole document) in view of Palmer (the ABSTRACT; FIG. 1 through FIG. 9; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; and col. 6, ll. 1-50) shows the method of claim 14 and subsequent base claims depending from claim 14.

Katz in view of Palmer lacks explicit recitation of the elements and limitations of claims 15-20, even though Katz in view of Palmer suggests same.

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Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 15-20 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 15-20, because such selection would have provided means to ensure that *“Only the valid coupons matching the list in the database may be actually redeemed. . . . [and] to electronically reimburse the merchants. . . .”* (see Palmer (col. 2, ll. 43-57)) and because such selection would have provided means *“for effecting remote commerce . . . which are particularly adapted for the intelligent selection and proffer of products, services or information to a user or customer.”* (See Katz (col. 8, ll. 34-40)).

CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

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(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or
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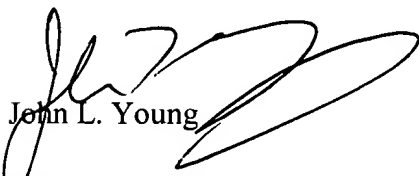
Hand delivered responses may be brought to:

Seventh floor Receptionist
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Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


John L. Young
Patent Examiner

June 1, 2003